

claims in one application does not invoke the recapture rule if those claims, as was the case here, are prosecuted successfully in one or more continuation applications. Exactly this situation was given in In re Clement, 131 F.3d 1464, 1469 (Fed.Cir. 1997) as an example of where the recapture rule would not apply:

[I]f an applicant amends a broad claim in an effort to distinguish a reference and obtain allowance, but promptly files a continuation application to continue to traverse the prior art rejections, circumstances would suggest that the applicant did not admit that broader claims were not patentable - assuming that the applicant does not ultimately abandon the continuation application because the examiner refuses to withdraw the rejections.

Here, every independent claim cancelled or amended in the '508 patent was later successfully prosecuted in a continuation application. Furthermore, whenever cancelling or amending a claim, the applicant carefully noted that such action did "not express acquiescence in the Examiner's rejections" (e.g., see the February 28, 1994 response in prosecution of the '508 patent, or the April 14, 1994 response in prosecution of the '724 patent). While the Applicant amended some claims, it was only to overcome § 112 rejections. And there was never a statement or action during prosecution from which an inference could be drawn that applicant conceded the unpatentability of any claimed subject matter in view of the prior art

The examiner has relied on the following provision from the MPEP (based on language from In re Clement) in reaching his conclusion on recapture:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

(MPEP § 1412.02). The Examiner's seems to assume that applicant falls into category (3)(b) by presenting claims lacking limitations found in cancelled claims but having limitations unrelated to prior art rejections. But in reaching that conclusion the examiner has overlooked the fundamental fact that in the present situation there are no "canceled or amended claims" on

which to base application of the recapture rule. Thus, none of the numbered provisions of this MPEP section apply in the present situation.

We could leave it right there, as the recapture rule has no applicability in the present situation, but for sake of completeness we want to point out two further grounds as to why the newly presented claims do not amount to recapture.

First, each of the newly presented claims include material limitations, not mere verbage or incidental language. As the MPEP indicates:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17.

Each of the pending reissue claims recite new material limitations. For example, claim 69 recites "determining a division of at least some of the signal elements into a plurality of bands" and "providing information describing the determined division." The previously prosecuted claims did not inherently include the new limitations nor are these limitations broadened versions of previously prosecuted limitations. Thus, for this further reason there is no recapture.

Second, the newly presented claims are directed not to subject matter surrendered during prosecution but to subject matter overlooked. The fact that the subject matter was overlooked demonstrates conclusively that it was not deliberately surrendered. As indicated in In re Hester,

[Claims may] overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he rightfully entitled for such overlooked aspects.

Hester Industries, 142 F. 3d 1472, 1482-1483. When an applicant has legitimately overlooked the possibility of claiming subject matter during the original prosecution, as here, there is no surrender and thus no recapture.